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In re Application of :
TORRES, Matthew, et al. :
U.S. Application No.: 09/926,094 :
PCT No.: PCT/US00/34535 : DECISION ON PETITION
International Filing Date: 20 December 2000 : UNDER 37 CFR 1.47(a)
Priority Date: 22 December 1999 :
Attorney's Docket No.: 114122.0115US :
For: FLOW-THRU CHIP CARTRIDGE, CHIP :
HOLDER, SYSTEM AND METHOD THEREOF :
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This decision is issued in response to applicants' petition under 37 CFR 1.47(a) filed on 01 October 2002. Applicants have submitted the required petition fee.

BACKGROUND

On 20 December 2000, applicants filed international application PCT/US00/34535 which claimed a priority date of 22 December 1999 and which designated the United States.

A Demand was not filed with the International Preliminary Examining Authority electing the United States prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was twenty months from the priority date, i.e., 22 August 2001.

On 30 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a petition to revive the application under 37 CFR 1.137(b) (because the basic national fee had not been submitted prior to the 22 August 2001 deadline, the application had become abandoned as of midnight on 22 August 2001).

On 30 November 2001, this Office issued a decision granting applicant's petition to revive under 37 CFR 1.137(b).

On 01 April 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497, the small entity surcharge for filing the declaration later than 30 months after the priority date, and additional fees based on the number and form of the claims presented, were required.

On 01 October 2002, applicants filed responsive materials which included payment of the required surcharge and fees, declarations executed by four of the five named inventors, the petition under 37 CFR 1.47(a) considered herein, and a petition/fee for a four month extension of time. Based on this extension, the 01 October 2002 filing is considered a timely response to the Notification Of Missing Requirements mailed 01 April 2002.

The petition seeks acceptance of the application without the signature of the nonsigning inventor Ian Stuart Richard SMITH, whom applicants assert cannot be located after diligent effort.

DISCUSSION

In order for the application to be accepted without the signature of the nonsigning inventor, applicants must submit a grantable petition under 37 CFR 1.47(a). A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the proper petition fee, (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

The petition included payment of the \$130 petition fee and it sets forth the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

With respect to item (3), applicants section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicant has submitted a declaration containing an unexecuted signature block for the nonsigning inventor and executed by the other inventors. Item (3) is therefore satisfied.

Regarding item (4), the proof required to show that a nonsigning inventor cannot be reached after diligent effort is set forth in section 409.03(d) of the MPEP, which states:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

...

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail, return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, the attempts to contact the nonsigning inventor are set forth in the statement of facts executed by above-named counsel. This statement reveals that applicants have mailed application materials to the nonsigning inventor's last known address (no longer current) and made a single telephone call was made to the inventor's last known employer (the call was not returned). The statement does not set forth any further efforts made to locate the inventor after applicants learned that the inventor had left his last known address and employer. Applicants must describe such search efforts (i.e., internet search, follow-up communications with the inventor's previous employer, etc.) before it can be concluded that the nonsigning inventor cannot be reached after diligent effort. Accordingly, item (4) is not satisfied.

Based on the foregoing, applicants have not satisfied all the requirements for a grantable petition under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include adequate evidence that the nonsigning inventor cannot be located after diligent effort including, as discussed above, evidence of efforts made by applicants to locate the nonsigning inventor after learning that his last known address was not current.

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.

RMR

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